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Dkt. 0575/62943/JPW/APE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Paul B. Fisher, et al.  
U.S. Serial No.: 09/648,310 Examiner: M. T. Tran  
Filed : August 25, 2000 Art Unit: 1642  
For : PROGRESSION SUPPRESSED GENE 13 (PSGen13) AND  
USES THEREOF

1185 Avenue of the Americas  
New York, New York 10036  
May 15, 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

AMENDMENT IN RESPONSE TO MARCH 15, 2001  
OFFICE ACTION AND PETITION FOR A ONE-MONTH EXTENSION OF TIME

This Amendment is submitted in response to the March 15, 2001 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. A reply to the March 15, 2001 Office Action was originally due April 15, 2001. Applicants hereby request a one-month extension of time. The fee for a one-month extension of time is FIFTY-FIVE DOLLARS (\$55.00) for a small entity and a check for this amount is enclosed herewith. Applicants have previously established small entity status. Therefore, a reply to the March 15, 2001 Office Action is now due May 15, 2001. Accordingly, this Amendment is being timely filed.

The Examiner acknowledged receipt and entry of the preliminary amendment on October 6, 2000 in which claims 2-8, 11-12, 23-25, 27-29, 31, 33, 35, 37, 39 and 41-43 were canceled without prejudice. The Examiner stated claims 1, 9-10, 13-22, 26, 30, 32, 34, 36, and 40 are pending.

Applicants: Paul B. Fisher, et al.  
Serial No.: 09/648,310  
Filed : August 25, 2000  
Page 5

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Election / Restriction

The Examiner asserted that restriction to one of the following allegedly independent and distinct inventions is required under 35 U.S.C. §121:

- I. Claims 1, 9-10 and 30, drawn to DNA of PS gene 13 protein and a vector and host cell containing same.
- II. Claims 13-21, drawn to a method of treating cancer using gene therapy.
- III. Claims 22 and 32, drawn to the protein of PS gene 13.
- IV. Claims 26 and 34, drawn to the antibody of PS gene 13 antigen.
- V. Claim 36, drawn to a method of inhibiting cancer cell growth.
- VI. Claim 40, drawn to a method of inhibiting angiogenesis.

The Examiner asserted that inventions I, II and IV are unrelated. The Examiner stated that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. The Examiner asserted that in the instant case, the different inventions of Groups I, II and IV are drawn to different structures with different chemical and physical properties which have different modes of operation, different functions and different effects.

The Examiner alleged that Inventions I, V and VI are related as product and process of use. The Examiner stated that the

Applicants: Paul B. Fisher, et al.  
Serial No.: 09/648,310  
Filed : August 25, 2000  
Page 6

inventions can be shown as distinct if either or both (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. The Examiner further alleged that in the instant case, the DNA of Group I can be used to label cells and does not have to be used to treat any diseases such as the methods of uses of Groups V and VI.

The Examiner also alleged that inventions II, V and VI are unrelated. The Examiner stated that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions or different effects. The Examiner asserted that in the instant case, the different inventions of Groups II, V and VI are drawn to different methods with different method steps, reagents and different outcomes.

The Examiner asserted that because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their alleged recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The Examiner stated that applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application.

Finally, the Examiner stated that the application currently names joint inventors and that in considering the patentability of the claims under 35 U.S.C. §103, the Examiner presumes that the subject

Applicants: Paul B. Fisher, et al.  
Serial No.: 09/648,310  
Filed : August 25, 2000  
Page 7

matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. The Examiner noted that applicant is advised of the obligation under 37 C.F.R. §1.56 to point out that the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103.

#### Applicants' Reply

In reply, applicants traverse the restriction requirement and elect Group I, claims 1, 9-10 and 30. Applicants submit that Group I and Group III should be joined. Applicants have added new claims 44-53 which are directed to nucleic acids and vectors and host cells which read on the invention of Group I.

Applicants maintain that Groups I and III are not independent because they are connected by design, operation, or effect under the disclosure of the particular application under consideration (M.P.E.P. §806.04). Applicants direct the Examiner's attention to claim 1 and claim 22, wherein it is shown that Group I and Group III are connected by the same effect via an isolated nucleic acid encoding a Progression Suppressed Gene 13 ("PSGen 13") protein. Claim 1 claims the isolated nucleic acid encoding PSGen 13 and claim 22 claims the isolated PSGen 13 protein itself. Claims 44-53 are directed to nucleic acids, vectors and host cells as set forth by the Examiner in Group I.

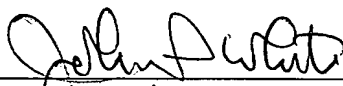
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned

Applicants: Paul B. Fisher, et al.  
Serial No.: 09/648,310  
Filed : August 25, 2000  
Page 8

attorney invites the Examiner to telephone at the number provided below.

No fee, except for the \$55.00 for the one-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any other fees are required, authorization is hereby given to charge the amount of any such fees to Deposit Account No. 03-3125.

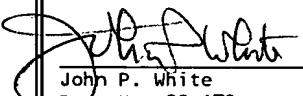
Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents  
Washington, D.C. 20231.

  
John P. White  
Reg. No. 28,678

5/15/01  
Date